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EXAMINER

LEE, TOMMY D

ART UNIT PAPER NUMBER

2624

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/640,972

Applicant(s)

TEHRANCHI ET AL.

Examiner

Thomas D. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.
2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
3. Misnumbered claims 41-47 have been renumbered 40-46, respectively. The dependency of the claims renumbered 42, 44 and 45 should be changed so that there is no claim depending from itself.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the data source" in lines 6-7 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 25-27, 31-33, 38, 39, 41 and 43-46 are rejected under 35

U.S.C. 102(b) as being anticipated by U.S. Patent 5,754,308 (Lopresti et al.).

Regarding claim 1, Lopresti et al. teach an output print produced by an image processing apparatus, comprising: a substrate having an image thereon (noting Fig. 5, output of either perfect copy 110 or ordinary copy 115); and a machine readable marking coupled to said substrate, wherein said machine readable marking identifies a data source (DocId, indicating file containing a digital representation of the page to be retrieved, printed on re-created page (column 4, lines 29-49)).

Regarding claim 2, Lopresti et al. teach an output print produced by an image processing apparatus, comprising: a substrate having an image thereon (noting Fig. 5, output of either perfect copy 110 or ordinary copy 115); and a machine readable marking coupled to said substrate, wherein said machine readable marking identifies at least one processing parameter employed by the image processing apparatus to process the image provided the data source (DocId further provides information regarding photocopying and facsimile reproduction parameters (column 5, lines 12-33)).

Regarding claim 3, Lopresti et al. teach an output print produced by an image processing apparatus, comprising: a substrate having an image thereon (noting Fig. 5, output of either perfect copy 110 or ordinary copy 115); and a machine readable marking coupled to said substrate, wherein said machine readable marking machine identifies a data source used to provide the image and identifies at least one processing

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parameter employed by the image processing apparatus to process the image provided by the data source (DocId, indicating file containing a digital representation of the page to be retrieved, printed on re-created page (column 4, lines 29-49); DocId further provides information regarding photocopying and facsimile reproduction parameters (column 5, lines 12-33)).

Regarding claim 25, Lopresti et al. teach a machine-readable marking on an output print having an image thereon produced by an image processing apparatus, said marking comprising encoded metadata describing the image, said metadata including an identifier defining a data source used to provide the image on the output print (DocId, indicating file containing a digital representation of the page to be retrieved, printed on re-created page (column 4, lines 29-49)).

Regarding claim 26, Lopresti et al. teach a machine-readable marking on an output print having an image thereon produced by an image processing apparatus, said marking comprising encoded metadata describing the image, said metadata including an identifier defining a processing operation used to process the image on the output print (DocId further provides information regarding photocopying and facsimile reproduction parameters (column 5, lines 12-33)).

Regarding claim 27, Lopresti et al. teach a machine-readable marking on an output print having an image thereon produced by an image processing apparatus, said marking comprising encoded metadata describing the image, said metadata including an identifier defining a data source used to provide the image on the output print (DocId, indicating file containing a digital representation of the page to be retrieved, printed on

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re-created page (column 4, lines 29-49)) and defining a processing operation used to process the image on the output print (DocId further provides information regarding photocopying and facsimile reproduction parameters (column 5, lines 12-33)).

Regarding claim 31, Lopresti et al. teach a method for coupling, to an output print, metadata describing an image generated from a data source, the method comprising the step of marking a machine-readable encoding on the output print, the encoding identifying the data source (DocId, indicating file containing a digital representation of the page to be retrieved, printed on re-created page (column 4, lines 29-49)).

Regarding claim 32, Lopresti et al. teach a method for coupling, to an output print, metadata describing an image generated from a data source, the method comprising the step of marking a machine-readable encoding on the output print, the encoding defining a processing operation used to process the image on the output print (DocId further provides information regarding photocopying and facsimile reproduction parameters (column 5, lines 12-33)).

Regarding claim 33, Lopresti et al. teach a method for coupling, to an output print, metadata describing an image generated from a data source, the method comprising the step of marking a machine-readable encoding on the output print, the encoding identifying the data source (DocId, indicating file containing a digital representation of the page to be retrieved, printed on re-created page (column 4, lines 29-49)) and defining a processing operation used to process the image on the output

print (DocId further provides information regarding photocopying and facsimile reproduction parameters (column 5, lines 12-33)).

Regarding claim 38, Lopresti et al. teach a method for marking identification data on an output print produced from a data source by an image processing apparatus, the method comprising the step of marking a machine-readable encoding that identifies the data source (DocId, indicating file containing a digital representation of the page to be retrieved, printed on re-created page (column 4, lines 29-49)).

Regarding claim 39, Lopresti et al. teach a method for marking processing data on an output print produced from a data source by an image processing apparatus, the method comprising the step of marking a machine-readable encoding that identifies at least one processing parameter used by the image processing apparatus to process the output print from the data source (DocId further provides information regarding photocopying and facsimile reproduction parameters (column 5, lines 12-33)).

Regarding claim 41, Lopresti et al. teach, for use with an image processing apparatus, a method for producing a first output from a data source, the method comprising the steps of obtaining, from a machine-readable marking on a second output print, a processing parameter for use by the image processing apparatus (DocId provides information regarding photocopying and facsimile reproduction parameters (column 5, lines 12-33) from page 100 (column 9, lines 17-24)); generating a setup file having the processing parameter by using data obtained from the machine-readable marking (document with appended DocId transmitted to a storage location for archiving (column 8, lines 35-47)); and providing the setup file to the image processing apparatus

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(reproduction parameters used to produce an enhanced, high quality photocopy of the page (column 5, lines 12-26)).

Regarding claims 43-45, Lopresti et al. teach an image processing system for printing image data on a first output print, wherein the first output print is substantially identical to a second output print, said image processing system comprising: a first printer for providing the second output print (printer 13 linked to first computer and equipped to output document marker 27 with the printed version of a document (column 3, lines 55-57)); a reader for obtaining setup data coupled to said first output print (document scanner 16 adapted to scan the document marker, as well as or separate from scanning of characters on the document (column 3, lines 57-59)); and a second printer for accepting the image data as input and printing the first output print, said first printer capable of printing based on the setup data (optional printer linked to a second computer for outputting a printed second version (column 3, lines 63-65; column 4, lines 14-28)). The image processing system further comprises a transmission link that connects said first printer with said second printer (printers linked via document scanner 16, computer system 2 (Fig. 1)). Said reader is a scanner (document scanner (column 3, line 57)).

Regarding claim 46, Lopresti et al. teaches a remote proofing system, comprising: a first printer for printing a first output print having an image thereon, wherein a marking containing metadata describing the image is coupled to said first output print (printer 13 linked to first computer and equipped to output document marker 27 with the printed version of a document (column 3, lines 55-57)); a reader for

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scanning the marking, said reader capable of providing said metadata in a metadata file (document scanner 16 adapted to scan the document marker, as well as or separate from scanning of characters on the document (column 3, lines 57-59); scanned document with appended DocId transmitted to a storage location during prior archiving of document (column 8, lines 35-47)); and a second printer for printing a second output print, wherein said second printer accepts said metadata file from said reader, said metadata file conditioning the operation of said second printer so that the second output print is substantially identical in appearance to said first output print (optional printer linked to a second computer for outputting a printed second version (column 3, lines 63-65; column 4, lines 14-28)).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4-7, 13, 14, 17-24, 28, 34, 35-37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti et al.

Regarding claims 4-6, Lopresti et al. teach an output print produced by an image processing apparatus, comprising a substrate having an image thereon (noting Fig. 5, output of either perfect copy 110 or ordinary copy 115); and a machine-readable marking coupled to said substrate, wherein said machine-readable marking comprises identifying encoding to identify a data source used to provide the image (DocId,

indicating file containing a digital representation of the page to be retrieved, printed on re-created page (column 4, lines 29-49)) and identifying encoding to identify at least one processing parameter employed by the image processing apparatus to process the image provided by the data source (DocId further provides information regarding photocopying and facsimile reproduction parameters (column 5, lines 12-33)).

Lopresti et al. do not appear to teach separate machine-readable markings for identifying the data source and processing parameters. However, whether a single or plural markings are used for identifying such information is inconsequential so long as the two pieces of information are identifiable by the markings. Providing separate markings would have been an obvious modification of Lopresti et al. for one of ordinary skill in the art, so that a user may easily confirm that information identifying a data source and processing parameters are both included in the output print.

Regarding claims 13 and 14, Lopresti et al. teach a machine-readable marking comprising identifying encoding to identify at least one physical characteristic of said substrate (photocopying and facsimile reproduction parameters include paper size and paper quality (column 5, lines 15-18)). Once again, providing separate markings would have been an obvious modification of Lopresti et al. for one of ordinary skill in the art, so that a user may easily confirm that all identifying information is included in the output print.

Regarding claims 19-24, the machine-readable marking is affixed to said substrate by printing (as noted above, DocId is printed on re-created page). Printing

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second and third machine-readable markings would have been an obvious modification to one of ordinary skill in the art, as noted above.

Regarding claim 28, Lopresti et al. teach a machine-readable marking on an output print having an image thereon produced by an image processing apparatus, said marking comprising encoded metadata describing the image, said metadata including: an identifier defining a data source used to provide the image on the output print (DocId, indicating file containing a digital representation of the page to be retrieved, printed on re-created page (column 4, lines 29-49)) and a processing operation used to process the image on the output print (DocId further provides information regarding photocopying and facsimile reproduction parameters (column 5, lines 12-33)).

Regarding claim 34, Lopresti et al. teach a method for coupling, to an output print, metadata describing an image generated from a data source, the method comprising the step of marking machine-readable coding on the output print, the encoding identifying a data source (DocId, indicating file containing a digital representation of the page to be retrieved, printed on re-created page (column 4, lines 29-49)) and defining a processing operation used to process the image on the output print (DocId further provides information regarding photocopying and facsimile reproduction parameters (column 5, lines 12-33)). Regarding claim 40, Lopresti et al. teach a method for marking identification and processing data on an output print produced from a data source by an image processing apparatus, the method comprising the step of marking machine-readable encoding that identifies the data source (DocId, indicating file containing a digital representation of the page to be retrieved, printed on re-created page (column 4,

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lines 29-49)) and at least one processing parameter used by the image processing apparatus to process the output print from said data source (DocId further provides information regarding photocopying and facsimile reproduction parameters (column 5, lines 12-33)). Again, while not taught by Lopresti et al., providing separate markings would have been an obvious modification of Lopresti et al. for one of ordinary skill in the art, so that a user may easily confirm that all identifying information is included in the output print.

Regarding claims 7, 17 and 18, Lopresti et al. disclose types of reproduction parameters contained in the information encoded in the DocId, such as exposure levels, paper size and paper quality (column 5, lines 15-18). While not disclosed in Lopresti et al., it would have been obvious to one of ordinary skill in the art that other types of print processing, as a matter of design choice, may be communicated to a processing apparatus using an identifier such as the DocId taught by Lopresti et al. or other data such as bar codes. Identification of prepress processing mechanisms or types of finishing mechanisms, including a laminator, are features which would have been obvious modifications of Lopresti et al. to one who desires such features.

Regarding claims 35-37, hash function values and digital signatures are well known and used in image data transmission and retrieval, and it would have been obvious for one of ordinary skill in the art to provide such information in the DocId information taught by Lopresti et al. for providing authentication and security to the image processing system.

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10. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti et al. as applied to claim 4 above, and further in view of U.S. Patent 5,644,408 (Li et al.). Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti et al. as applied to claim 13 above, and further in view of Li et al. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti et al. as applied to claim 28 above, and further in view of Li et al. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti et al. as applied to claim 41 above, and further in view of Li et al.

Claims 10, 11, 16, 30 and 42 each recite a machine-readable marking using a bar code reader, and claim 12 recites a machine-readable marking that is invisible. The DocId information taught by Lopresti et al. is not disclosed as being a bar code. However, Li et al. teach the use of a bar code containing information for processing a document on which the bar code is printed (column 3, line 64 – column 4, line 3). The bar code is read by a scanner/decoder (column 4, lines 12-14). Bar codes containing information to be decoded by a bar code reader are well known in the art, and it would have been obvious for one of ordinary skill in the art to use bar codes for the DocId information taught by Lopresti et al., since bar coding is a convenient method for entering information into a data processing system. Furthermore, it is generally well known in the art to print a bar code using invisible ink on a document, and it would have been obvious for one of ordinary skill in the art to use invisible ink for printing the bar code so that the bar code may be read, while not interfering with the content of the document as viewed by a person.

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11. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti et al. as applied to claim 4 above, and further in view of U.S. Patent 6,426,806 (Melen). Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti et al. as applied to claim 13 above, and further in view of Melen. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti et al. as applied to claim 28 above, and further in view of Melen.

Claims 8, 9, 15 and 29 each recite a machine-readable marking that is human-readable. The DocId information taught by Lopresti et al. is not disclosed as being human-readable. However, Melen teaches the use of either human-readable characters or bar codes as information on a control sheet used for routing image data (column 2, lines 25-30). The human-readable characters are read by a scanning system, which is a machine. It would have been obvious to one of ordinary skill in the art to replace the DocId information in Lopresti et al. with human-readable characters, which are obviously easier for a user to read and which allows the user to positively identify a type of processing to be performed.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,119,132 (Kuwano) discloses an image filing system using a registration sheet with an ID image pattern including apparatus ID and image ID information.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-

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4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl
March 5, 2004